

R E M A R K S

After careful consideration of the outstanding Office Action, this application has been amended toward hopefully obtaining the allowance of the claims of record, and favorable reconsideration toward the latter end is herewith respectfully requested.

Before considering the objections/rejections set forth in the outstanding Office Action, the Examiner is advised that this amendment is believed to present claims which clearly and unequivocally avoid all rejections of record, including the rejection under 35 U.S.C. § 103(a). Therefore, upon consideration of the claims now of record and the arguments presented hereinafter, the formal allowance of the application would be most appreciated. Absent the formal allowance of this application, the Examiner is requested to telephone the undersigned so that a personal interview can be arranged between the Examiner and the undersigned. In other words, if this application is not formally allowed, the undersigned wishes to discuss the same personally with the Examiner **absent** a formal action on the merits by the Examiner.

Also, the undersigned would like to bring to the Examiner's attention two inadvertent errors in the last amendment. In the "Listing of Claims," claims 3 and 13 were listed as "Previously Presented" claims when they should have been listed as "Currently Amended" claims. These were typographical errors, and it is assumed that the amendments were entered. If not, please enter the amendments to claims 3 and 13 as indicated in the Amendment of August 4, 2003 by Examiner's Amendment.

Beginning at page 2, paragraph 2 of the outstanding Office Action, the Examiner rejected all of the claims of record "under 35 U.S.C. 112, second

paragraph, as being indefinite." All of the claims requiring amendment have been amended to avoid this rejection and the reasons set forth by the Examiner in support thereof. For example, both independent claims have been amended to recite "means (5) for retaining the liner (6) in the closure shell (2A)." The latter limitation renders moot the Examiner's concern of the manner in which the liner (6) is retained in the closure (2). For the record, the means-plus-function limitation added to the independent claims covers not only the "retaining bead 5," as the Examiner suggested, but equivalents thereof.

The use of "includes" and "it" have been avoided, and claim 6, line 10 has been rendered clear by now reciting "**the** in-bore device." With respect to the phrase following the semi-colon in claims 3, 7 and 13, these phrases are not "redundant and unnecessary" because they are not "previously set forth" in the "independent claims," as the Examiner has stated. In each of dependent claims 3, 7 and 13, the Examiner will find the word "completely" in the phrase "folding completely flat." In the independent claims, the corresponding phrase is "folding flat." Therefore, dependent claims 3, 7 and 13 are more specific than the claims from which they depend and are neither "redundant" nor "unnecessary."

In view of the foregoing, the withdrawal of the 35 U.S.C. § 112, second paragraph, rejection is believed to be in order and is respectfully requested.

Claims 1 through 9 and 11 through 18 were rejected "under 35 U.S.C. 103(a) as being unpatentable over Erba (EP847,930) in view of Hatakeyama et al. (US 4,238,042)." (See outstanding Office Action, page 2, paragraph 4.) The Examiner next describes that which Erba allegedly "teaches" at

page 3, first full paragraph, and in paragraph 5 states: "some of the structural features of the applied prior art do not have associated reference characters," and thus "none could be used," though the Examiner "made every attempt to provide reference characters or descriptions of the referenced structure where possible." Unfortunately, because of the latter, the Examiner has not satisfied the Graham conditions, particularly with respect to "the scope and content of the prior art" and the "differences between the prior art and the claims at issue." See Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

In order to facilitate a clear understanding of the Erba patent and the Examiner's application thereof, the undersigned has attached to this amendment a photocopy of Figures 2 and 3 of the Erba patent and has applied thereto reference numerals (1) through (8). Thus, the sealing disk (23) of Erba clearly discloses a planar annular end panel (1), an upper radially inboardmost radius portion (2), an innermost peripheral wall (3), a lower radially inboardmost radius portion (4), a bottom short annular wall (5), a lower radially outermost radius portion (6), an outermost peripheral wall (7), and a terminal edge (8) of the outermost peripheral wall (7). The latter is believed an accurate description of the Erba sealing disk (23) and presumably structural portions (1) through (7) include the "preventing means seen in Figure 1" described by the Examiner as "surrounding central portion (23), except for an upstanding rim portion (the outermost unnumbered portion of surrounding central portion (23) of a sealing flange) which cams along the closure to fold toward the sealing flange upon application of the closure to a container." The "upstanding rim portion" referenced by the Examiner is undoubtedly meant to be the outermost

peripheral wall (7) of the attached Erba drawings. The outermost peripheral wall (7) of Erba is not disclosed as being made of "resilient material" and at no time is it "folded inward by the closure shell (2A)." (See claim 1.) Instead, the outermost peripheral wall (7) of Erba is held between the end panel of the closure against which the terminal edge (8) bottoms (Figures 1 and 2) and the annular shoulder (421). If the Examiner will compare Figures 1 and 2, she will note that the relationship of the outermost peripheral wall (7) remains the same in both figures prior to the two capsule parts (20, 21) being assembled to the neck of the bottle (B, Figure 1) and after being assembled to the bottle (B, Figure 2). In other words, the outermost peripheral wall (7) is **not** folded, deflected or in any manner changed physically and performs **no** sealing function whatsoever with respect to the closure or the bottle. Rather, sealing functions are performed by "a first peripheral flexible sealing lip 24" of the sealing disk (23) though "the main sealing action is provided at the central basket 10" by the cylindrical protrusion (25) "which is coaxial to the central basket 10, and is meant to sealingly interact with the cylindrical or substantially cylindrical edge of the central basket 10, particularly in the area in which the latter is jointed to the flange 9, superimposed on the edge of the mouth 2 of the bottle." (See column 4, lines 41 through 54 and continuing at page 5, lines 2 through 15.)

Therefore, in the context of independent claims 1 and 6, there is no "sealing" flange corresponding to the sealing flange (31) claimed and the outermost peripheral wall (7) of Erba is nowhere stated as being constructed "of resilient material" to achieve inward folding "by the closure (2A)" or upon

“application of the closure shell (2A) on the container” (claims 6 and 1, respectively).

It ought be relatively apparent that since the outermost peripheral wall (7) of Erba is not a sealing flange and does not fold inwardly, Erba also lacks means (42) radially inboard of said upstanding rim (40) for preventing said upstanding rim (40) from folding flat. (See claims 1 and 6).

“Before obviousness may be established, the Examiner must show that there is either a suggestion in the art to produce the claimed invention or a compelling motivation based upon sound scientific principles.” See Ex parte Kranz, 19 USPQ2d 1216, 1218, citing Carl Schenck A.G. v. The Norton Corp., 713 F.2d 782, 218 USPQ 698, 702 (Fed. Cir. 1983). Where in the patent to Erba does the Examiner find a suggestion of a sealing disk retained in a closure which can be folded inwardly upon application of an associate closure to a container mouth? Nowhere!

“Among legal standards for determining *scope* and content of the prior art, for example, are: a prior patent must be considered in its entirety, *i.e.*, as a *whole*, including portions that would lead away from the invention in suit... elements of separate prior patents cannot be combined when there is no suggestion of such combination anywhere in those patents... and a court (and Examiners) should avoid hindsight.” See Panduit Corp. v. Dennison Manufacturing Co., 1 USPQ2d 1593, 1597.

With due respect, the Examiner is quite correct in stating that Erba lacks “a sealing flange which cams along the closure to fold toward the sealing flange upon application of the closure to a container,” and just as importantly is the fact that both Erba and Hatakeyama et al. fail to provide a suggestion thereof.

Turning specifically to the Hatakeyama et al. patent, the Examiner states the same "teaches a closure 4 having a sealing flange having an upstanding rim 12 that folds toward the sealing flange upon application of the closure to a container." Unspoken by the Examiner is the fact that the upstanding rim (12) of the Hatakeyama et al. patent is housed in telescopic relationship to a cap inner member (2) and the upstanding rim (12) is deflected inwardly by an upper wall portion (21) of the cap inner member (2), not "on application of the closure shell (2A) on the container." (See claims 1 and 6.) The closure or cap outer member (3) of Hatakeyama et al. is applied upon the container in Figure 1, yet the upstanding rim (12) remains unfolded. Accordingly, structurally and functionally there is no correspondence between the Hatakeyama et al. upstanding rim (12) and that recited in independent claims 1 and 6 herein.

The undersigned also notes with interest that in the rejection of claims 1 through 9 and 11 through 18 under 35 U.S.C. § 103(a), the Examiner totally ignores the last limitation of each of claims 1 and 6, namely, "means (42) radially inboard of said upstanding rim (40) for preventing said upstanding rim (40) from folding flat." Where is such structure found in either of the two applied patents? Perhaps as importantly, why has the Examiner disregarded the last limitation of claims 1 and 6? Clearly, the outermost peripheral wall (7) of the Erba patent does not and cannot fold inwardly, irrespective of the Hatakeyama et al. disclosure. Thus, the Examiner has in the Erba patent an outermost peripheral wall (7) which does not and cannot fold inwardly and in Hatakeyama et al. the Examiner has an upstanding rim (12) that does fold inwardly, but neither patent fairly suggests, discloses or renders obvious "means (42) radially inboard of said

upstanding rim (40) for preventing said upstanding rim (40) from folding flat."

In view of the foregoing, since claims 1 and 6 are clearly directed to unobvious subject matter and since the Section 103(a) rejection of record is completely erroneous, the withdrawal of the latter reflection and the formal allowance of all of the claims of record is believed proper and would be most appreciated.

Several additional comments are believed to be in order concerning statements made by the Examiner under the caption "Response to Arguments."

As was acknowledged earlier herein, it is appreciated that "some of the structural features of the applied prior art do not have associated reference characters" and thus "none could be used," as stated by the Examiner. However, the undersigned found it relatively easy to make a copy of the Erba patent and apply reference characters thereto. The Examiner could readily and easily do the same and if the Section 103(a) rejection is continued, the undersigned would appreciate being provided a drawing of each of the applied patents with a reference character applied thereto designating the structure which the Examiner considers comparable to or suggestive of the recited "means (42) radially inboard... from being folded flat" of claims 1 and 6.

The latter is not considered to be an extraordinary request because, as set forth in Section 2143 of the Manual of Patent Examining Procedure, captioned "Basic Requirements of a Prima Facie Case of Obviousness," the Examiner is clearly required to meet "three basic criteria," and "there must be some suggestion or motivation" in the references "to modify the

reference or to combine reference teachings." Furthermore, "the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicants' disclosure." In re Vaeck, 947 F.2d 488, 20 USPQ2d, 1438 (Fed. Cir. 1991). The Examiner's total silence with respect to the last limitation of each of independent claims 1 and 6 clearly establishes the absence of a *prima facie* case of obviousness. Moreover, when the prior art disclosures of Erba and Hatakeyama et al. are considered in their entireties or "*as a whole*," it is quite clear that neither reference singularly nor in combination either teaches or suggests the subject matter recited in independent claims 1 and 6. With all due respect, the Examiner's attempt at a legal, equitable and viable rejection under 35 U.S.C. § 103(a) is predicated upon nothing other than "applicants' disclosure." (In re Vaeck, *supra*.)

In the first sentence of the paragraph bridging pages 3 and 4 of the outstanding Office Action, the Examiner correctly states that the utilization of the word "comprising" constitutes an "open" limitation which "does not preclude additional structure from being disclosed in the prior art reference." The undersigned agrees with the latter analysis. However, in the earlier Amendment After Final Rejection of August 4, 2003, at page 9, paragraph 1, the undersigned questioned: "Where in the Erba patent is there found either the 'spacer (42) between opposed surfaces of the sealing flange (31) and the closure shell (2A)' of claim 3 or the broader recited 'means (42) radially inboard of said upstanding rim (40) for preventing said upstanding rim (40) from folding flat'?" (See independent claims 1 and 6). The latter question has two parts and the Examiner presumably answered the first part of the question in the sentence bridging pages 3 and 4 of the outstanding Office

Action even though the “upstanding rib portion” of Erba cannot be folded for the reasons earlier discussed herein, namely, the upstanding rim portion is merely retained or confined immovably between the end panel and the annular shoulder (421). If the last limitation of independent claims 1 and 6 is considered an “open phrase” and the Examiner believes the prior art includes “additional structure” which renders the last limitation of claims 1 and 6 obvious, the undersigned would be most appreciative if the Examiner would identify the same.

At page 4 of the outstanding Office Action, first full paragraph, there is absolutely nothing at page 9, paragraph 1 through page 10, paragraph 1 of Applicants’ last remarks which “misrepresent the prior art as applied” in any fashion. The undersigned respectfully insists that the Examiner explicitly define exactly that which she considers to “misrepresent the prior art.” With due respect, “comment is necessary by the Examiner.”

The Examiner correctly paraphrases in two sentences a single sentence from the In re McLaughlin decision (443 F2d 1392, 170 USPQ 209 (CCPA 1971) of the outstanding Office Action. However, the preceding sentence states “that the test for combining references is not what the individual references themselves suggest but rather what the combination of disclosures taken *as a whole* would suggest to one of ordinary skill in the art.” Immediately following the sentence paraphrased by the Examiner, the predecessor court of the Federal Court of Appeals for the Federal Circuit concludes “we agreed that those references would have suggested use of such panels and bulkheads with the Cook car for the same purpose.” Quite simply, the law has not changed and if the combination of prior art is not suggestive of the invention claimed, then the reconstruction thereof is

necessarily "gleaned only from the applicant's disclosure." Perhaps a better and clearer statement on the issue of obviousness/hindsight is found in the decision of C.R. Bard Inc. v. M3 Systems, Inc., 48 USPQ2d 1225, 1231 and the following comments and case law are reproduced verbatim therefrom:

[O]bviousness is a question of law based on underlying facts. See *Graham v John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966); *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1566-68, 1 USPQ2d 1593, 1595-97 (Fed. Cir. 1987). The relevant facts relate to (1) the scope and content of the prior art, (2) the level of ordinary skill in the field of the invention, (3) the differences between the claimed invention and the prior art, and (4) any objective evidence of nonobviousness such as long felt need, commercial success, the failure of others, or copying. *Graham*, 383 U.S. at 17, 148 USPQ at 467; see *Continental Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 1270, 20 USPQ2d 1746, 1750-51 (Fed. Cir. 1991).

The ultimate determination of obviousness *vel non* is a legal conclusion. See *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 297 n.24, 227 USPQ 657, 667 n.24 (Fed. Cir. 1985). When a patent describes a new mechanical device that can be viewed as a new combination or arrangement of mechanical components, the legal conclusion of obviousness requires that there be some suggestion, motivation, or teaching in the prior art whereby the person of ordinary skill would have selected the components that the inventor selected and used them to make the new device. See *Heidelberger Druckmaschinen AG v. Hantscho Commercial Prds., Inc.*, 21 F.3d 1068, 1072, 20 USPQ2d 1337, 1379 (Fed. Cir. 1993) ("When the patented invention is made by combining known components to achieve a new system, the prior art must provide a suggestion or motivation to make such a combination."); *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 934, 15 USPQ2d 1321, 1323 (Fed. Cir. 1990) (it is insufficient that prior art shows similar components, unless it also contains some teaching, suggestion, or incentive for arriving at the claimed structure).

Though the prior art patents to Erba and Hatakeyama et al. show "similar components," neither of these patents contain "some teaching, suggestion or incentive for arriving at the claimed structure" recited in independent claims 1 and 6.

Based upon the claims of record, the arguments presented herein and the cases cited and properly applied by the undersigned, the formal allowance of this application is indeed considered to be in order and is herewith respectfully requested.

However, it is again repeated for the record that should the Examiner not allow the application (or indicate that all claims contain allowable subject matter), the Examiner is requested to telephone the undersigned in order that an interview can be arranged to personally discuss the issues of record with the Examiner.

Respectfully submitted,

DILLER, RAMIK & WIGHT

By: 

Vincent L. Ramik, Attorney
Registration No. 20,663

Merrion Square Suite 101
7345 McWhorter Place
Annandale, Virginia 22003

(703) 642-5705 - phone
(703) 642-2117 - fax

Attachments: Figs. 2 and 3 of EP 0 847 930 A1 (Erba)

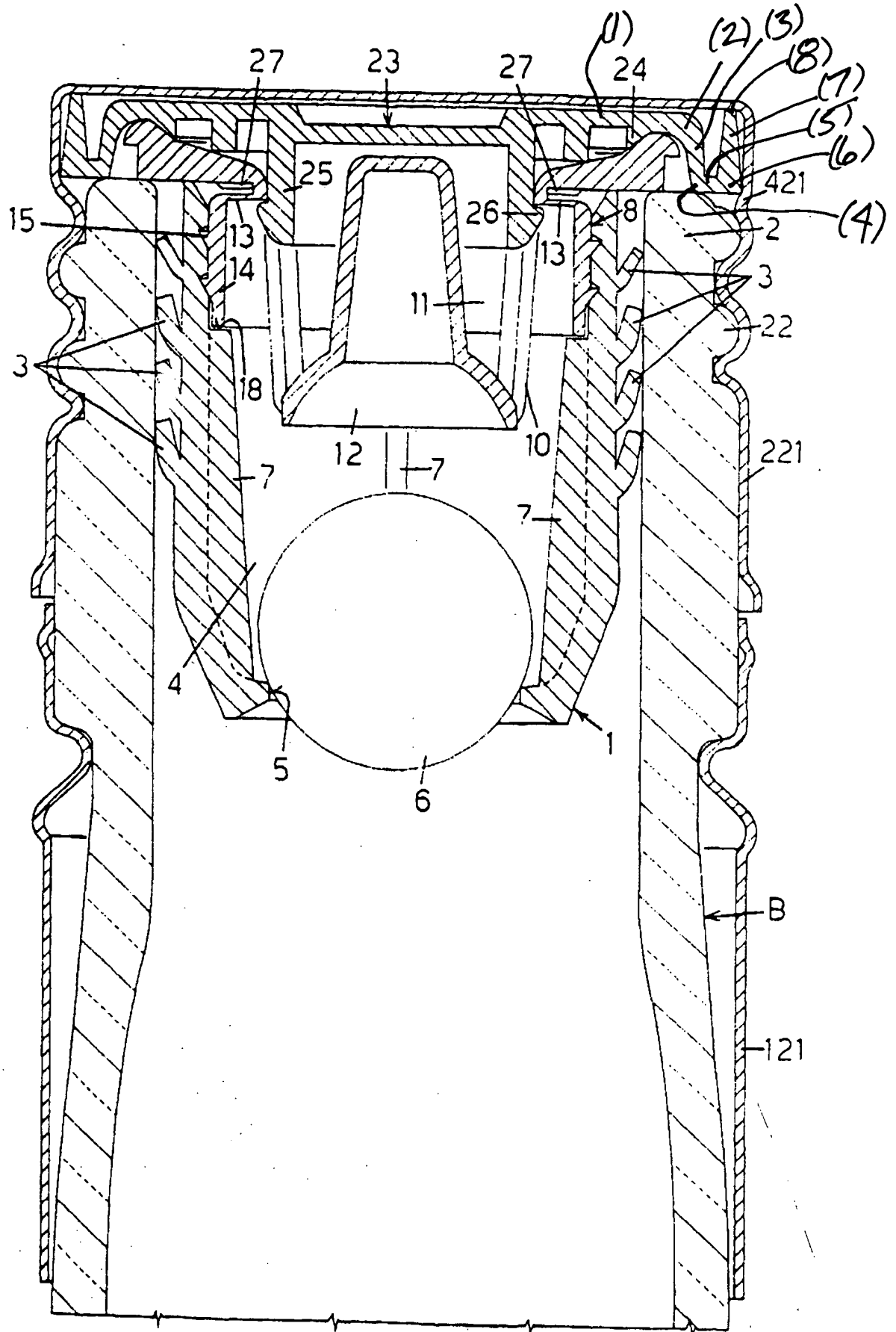


FIG. 2

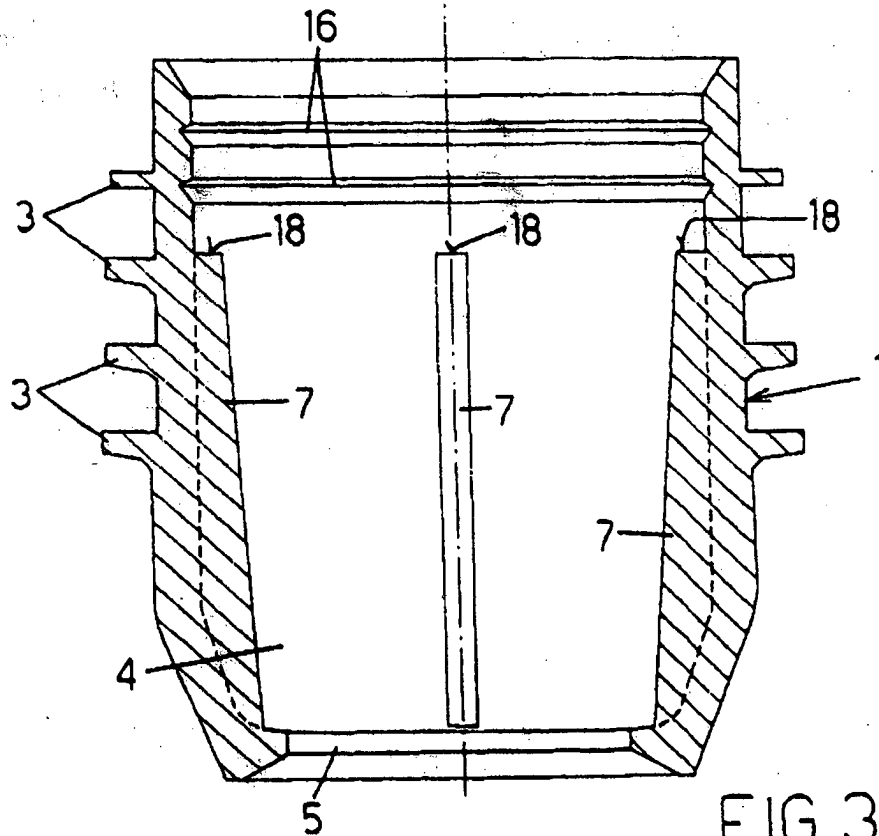
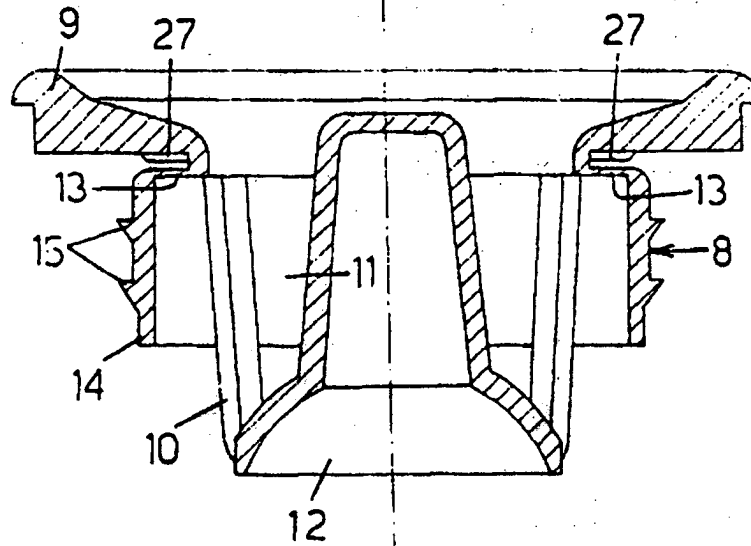
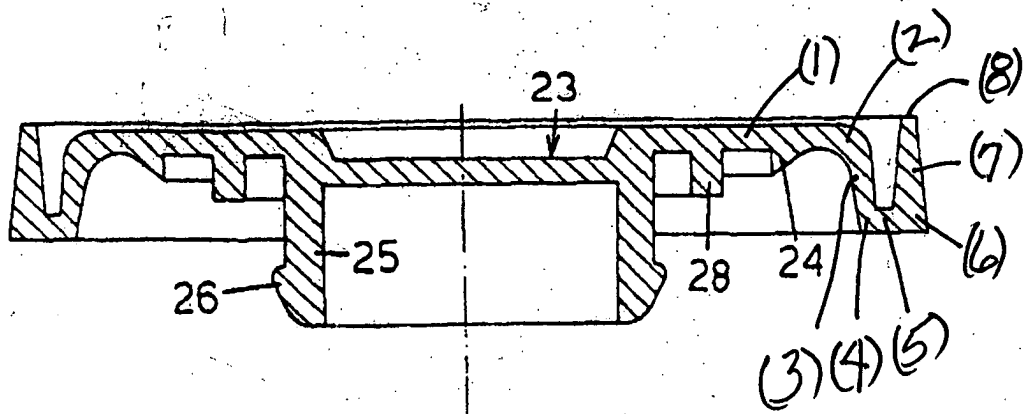


FIG. 3